



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/579,422

05/11/2006

Chandra Mohan

PTU030008

1419

24498

7590

06/19/2009

Thomson Licensing LLC

P.O. Box 5312

Two Independence Way

PRINCETON, NJ 08543-5312

EXAMINER

JAMAL, ALEXANDER

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

06/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/579,422 | Applicant(s) MOHAN ET AL. | |
| | Examiner ALEXANDER JAMAL | Art Unit 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Based upon the submitted amendment entered via RCE, the examiner notes that claim 1 has been amended.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-17** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite that the audio gateway provides ‘cellular phone features’ to a POTS phone. It is not clear exactly what defines a ‘cellular phone feature’. For the purpose of examination, the examiner assumes a cellular phone feature is any signaling or function that can be performed or triggered by a phone on a cellular network.

Correction/Clarification is requested.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1,2,8,10,15,16** rejected under 35 U.S.C. 102(e) as being anticipated by Tell et al (US 20060019666 A1).

As per **claim 1**, Tell discloses a combined POTS and cellular interface that can switch from one network to the other or use both simultaneously. The device can communicate with POTS and cellular networks (via a line switcher) and also to cell terminals and POTS phone (which inherently requires a SLIC) at the residence (Fig. 1). When the POTS phone is connected to a cellular network, the phone can perform ‘cellular phone features’ via the disclosed interface. The examiner reads the software

Art Unit: 2614

(which is inherently required in order to implement the disclosed interface) as a 'profile' to provide the cellular phone features to the POTS phone.

As per **claim 2**, the POTS interface inherently comprises a SLIC and DTMF interface as those are both interfaces designed specifically to implement the POTS network.

As per **claim 8**, the system comprises a wired phone input to the device, which inherently comprises a 'remote extender' to allow communications. Any portion of interface may be considered a remote extender.

As per **claims 10,15,16**, they are rejected as per the claim 1 rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 3-7,11-14,17,9** rejected under 35 U.S.C. 103(a) as being unpatentable over Tell et al (US 20060019666 A1).

As per **claim 3-7,11-14,17**, Tell discloses an interface for a residence and contemplates any number of terminals (including cell phones that inherently require modems for the purpose of modulating the carriers waves for wireless transmission) that may be serviced at the residence, but does not specify every possible known protocol or

Art Unit: 2614

standard that may be used to interconnect the networked devices (such as AT, caller ID, PCM, bluetooth, infrared, USB, RS232, DTMF).

It would have been obvious to implement any number of connections using any number of known protocols for the purpose of implementing the disclosed network. Each protocol inherently requires a respective module or modules be integrated into the system in order to translate one protocol to the next in the disclosed network.

As per **claim 9**, it would have been obvious to utilize a known support structure for a cellphone for the inherent advantage of supporting the device.

Response to Arguments

1. Applicant's arguments have been considered but are not persuasive.

As per applicant's arguments regarding the 112 rejection of the cellular features in the claims, the examiner maintains that applicant's specification does not clearly define what a cell phone feature is, or how to differentiate a feature from a non-feature, or how to differentiate two separate features (for example, 'making a call' could be thought of as a single feature, or a combination of a number of features, such as dialing a phone, ringing a phone, sending handshaking information). It is not clear what exactly defines a feature or how to determine the 'metes and bounds' of a 'feature'. The examiner recommends applicant claim the specific functions performed by the cellular phones instead of using the vague term 'feature'.

Art Unit: 2614

As per applicant's arguments that Tell does not disclose a gateway that provides (via a profile) cellular phone features to a POTS telephone, the examiner disagrees. The examiner notes Tell Fig. 1 and specifically softswitch 119, which acts as a gateway to interface protocols (features) between the POTS and wireless network. The examiner notes that any signaling or function performed in a wireless network is considered an 'additional feature' of the cellular phone that is provided to the POTS telephone via the gateway softswitch 119. Any signaling performed by the POTS phone on the cellular network is considered an additional feature offered by a cellular phone. Additionally, any signaling between a POTS phone and cellular phone via the softswitch would comprise a number of features (dialing, ringing, answering ect..) shared by both phones (additional features offered by a cellular phone).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498, and whose email address is alexander.jamal@uspto.gov

The examiner can usually be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone or email are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 571-272-7499.

Art Unit: 2614

The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and **571-273-8300** for After Final communications.

/Alexander Jamal/

Primary Examiner, Art Unit 2614

Examiner Alexander Jamal

June 18, 2009